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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,170	04/26/2002	Hiroaki Kuno	218131US3PCT	4382

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT PAPER NUMBER

1762

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A-2-7

Office Action Summary	Application No.	Applicant(s)	
	10/048,170	KUNO ET AL.	
	Examiner	Art Unit	
	Katherine A. Bareford	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers *Claims 3-8 are canceled*

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner notes that the case as filed has claims 1-2 pending (listed as "amended"), and claims 3-8 are listed as "cancelled".

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The controlled modulus and internal friction should be mentioned. Also, no product claims are provided.

3. The abstract of the disclosure is objected to because standard idiomatic English should be used. Correction is required. See MPEP § 608.01(b).

The abstract contains confusing, non-standard English. Note especially, the first two lines and last two lines.

4. The disclosure is objected to because of the following informalities: (1) at the first line of the specification, after the title, it should be indicated that this case is a national stage application of PCT/JP00/05282, filed August 4, 2000. (2) at page 11, line 5, " 1×10^{-3} " should apparently be " 1×10^{-3} ".

Appropriate correction is required.

Claim Objections

5. The Examiner notes the wording of claim 2, line 2, "such as a mouthpiece for wind instruments and the like" does not further limit the claim from "resonator pipe".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As worded, claim 1 requires "an internal friction in terms of its natural logarithm of at most 1×10^{-3} " for the produced ceramic product (see last two lines of the claim). This corresponds to the teaching of page 11, lines 2-5. However, it contradicts the rest of the specification. At page 11, second paragraph, it is indicated that the formed body should have a degree of internal friction of "at least 1×10^{-3} ", and preferably "at least 2×10^{-3} ". Furthermore, the exemplary formed bodies of the invention (examples 1 and 2), clearly are indicated of having internal friction greater than 1×10^{-3} . See, for example, figure 5 (examples 1 and 2), figure 7 (example 2) and Tables 5 and 6 on page 20 (as to example 2). As a result of these directly contradictory teachings, one of ordinary skill in the art would not be enabled to make and/or use

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the invention without performing undue experimentation to determine what internal friction is actually acceptable in forming a working invention. Dependent claim 2 does not correct the described defects of claim 1.

Conclusion

8. The Examiner notes that the closest prior art, to EP 377980 teaches making a musical instrument body by impregnating a ceramic with a liquid resin. However, this reference does not teach or suggest the claimed elastic modulus or internal friction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kath A/B/D
KATHERINE A. BAREFORD
PRIMARY EXAMINER
GROUP 1100/700